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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,746	09/05/2003	Robert Tonkin	31492-35	6130
7590	08/23/2006		EXAMINER [REDACTED]	FABER, DAVID
Joseph G. Swan, Esq. MITCHELL SILBERBERG & KNUPP, LLP 11377 West Olympic Boulevard Los Angeles, CA 90064			ART UNIT [REDACTED]	PAPER NUMBER 2178

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/655,746	TONKIN, ROBERT
	Examiner David Faber	Art Unit 2178
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b>		
<b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</b>		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b>		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>05 September 2003</u> . 2a) <input type="checkbox"/> This action is FINAL.                            2b) <input checked="" type="checkbox"/> This action is non-final. 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.		
<b>Disposition of Claims</b>		
4) <input checked="" type="checkbox"/> Claim(s) <u>28-81</u> is/are pending in the application. 4a) Of the above claim(s) _____ is/are withdrawn from consideration. 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. 6) <input checked="" type="checkbox"/> Claim(s) <u>28-81</u> is/are rejected. 7) <input type="checkbox"/> Claim(s) _____ is/are objected to. 8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.		
<b>Application Papers</b>		
9) <input checked="" type="checkbox"/> The specification is objected to by the Examiner. 10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>05 September 2003</u> is/are: a) <input type="checkbox"/> accepted or b) <input checked="" type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.		
<b>Priority under 35 U.S.C. § 119</b>		
12) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All    b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
* See the attached detailed Office action for a list of the certified copies not received.		
<b>Attachment(s)</b>		
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/5/2003</u>		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.		

**DETAILED ACTION**

1. This office action is in response to the application and the preliminary amendment filed on 5 September 2003.

**This action is made Non-Final.**

2. Claims 1-27 have been cancelled by the Applicant. Claims 28-81 have been added.
3. Claims 28-81 are pending. Claims 28, and 55 are pending.

***Priority***

4. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

***Information Disclosure Statement***

5. The information disclosure statement filed 5 September 2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because references listed under the Other Documents fail to indicate the pertinent page(s) for some of the references listed. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the

statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

*Drawings*

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 304, 436, 622, 682. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "432" has been used to designate both 363 printed pages and tab page as it is written in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if

only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "433" and "432" in the specification have both been used to designate a tab page, reference characters "434" and "433" in the specification have both been used to designate 363 printed pages, reference characters "435" and "434" in the specification have both been used to designate 363 printed pages, and reference characters "436" and "435" in the specification have both been used to designate a back cover. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 54 and 81 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner is unable to find within the specification of the user interface not printing on some of the selected physical assembly components.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 28-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. As per claims 28, and 55, the claim limitation recites "substantially arbitrary selection". Examiner is unsure what the Applicant by the use of the terminology within the claims, thus making it vague and indefinite. Therefore, throughout this Office action, Examiner view the terminology as "...selection."

14. As per claims 49, and 76, the claim limitation recites "substantially arbitrary insert". Examiner is unsure what the Applicant by the use of the terminology within the

claims, thus making it vague and indefinite. Therefore, throughout this Office action, Examiner view the terminology as "...insert."

15. Claims 28, 29, 39-44, 51, 55, 56, 66-71, and 78 recites the limitation "...the custom-design information". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 28-32, 34, 36-38, 40, 42-46, 48-50, 52-53, 55-59, 61, 63-65, 67, 69-73, 75-77, and 79-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Markovic et al (US Patent #7,047,490, filed 11/26/1997).

As per independent claim 28, Markovic et al discloses a method comprising:

- (a) providing a user interface that permits substantially arbitrary selection and arrangement of a variety of different physical assembly components for manufacturing an assembled document, thereby allowing a user to custom-design the assembled document; and (b) inputting the custom-design information via the user interface. (Column 4, lines 24-60, FIG 6): Using a virtual document assembly program, the user selects features and options to custom-design the assembled document including options of how the physical assembly components will look such as binding and the covers.

- (c) obtaining digital images of the physical assembly components specified in the custom-design information, at least to the extent of said digital images are needed to provide a desired view of the assembled document; (d) generating an image of the assembled document by combining the obtained digital images in a manner so as to simulate the desired view of the assembled document if the assembled document were to be physically produced according to the custom-design information; and (e) causing the image of the assembled document to be displayed. (Column 4, line 60 – Column 5, lines 25; FIG 1, 2D-2F; Col 6, lines 7-35: After parameters have been selected, the parameters are added to the original document to modify the visual appearance to include the added parameters to a modified visual appearance of which the user desired.)

As per dependent claim 29, Markovic et al discloses further comprising a step of responding to an edit command after the image has been displayed in step (e), by allowing a user to modify at least some of the custom-design information input in step (b) (Column 5, lines 26-33: May add, change or delete document assembly parameters after viewing)

As per dependent claim 30, Markovic et al discloses further comprising a step of generating and displaying a new image based on the assembled document based on the modified custom-design information. (Column 5, lines 26-33; FIG 1: then view the modified augmented electronic document after updating the parameters)

As per dependent claim 31. Markovic et al discloses wherein the user interface permits the user to custom-design at least one of the physical assembly as a set of printed-page images that have been generated using content from a source file provided by the user via the user interface. (FIG 1, Column 3, lines 35-51; Column 4, lines 4, lines 25-34 : The augment document assembled using user selected parameters by using the original source document that appears on the screen will look exactly how it will appear printed out. )

As per dependent claim 32, Markovic et al discloses the user interface permits the user to select a medium type for the printed-page images (Column 2, lines 34-36)

As per dependent claim 34, Markovic et al discloses further comprising a step of responding to a user command selecting a different portion of the assembled document by obtaining and displaying a new image which simulates an appearance of said different portion of the assembled document (FIG 2D-F, Column 4, line 66 – Column 5, line 25: User has the option to view the front cover pages, interior pages, or the back cover pages.)

As per dependent claim 36, Markovic et al discloses the user command is an instruction to turn to a specified page in the assembled document. ((FIG 2D,F, Column 4, line 66 – Column 5, line 25: User has the option to turn to just the front cover page, or the back cover page)

As per dependent claim 37, Markovic et al discloses wherein an object is stored for each physical assembly component, and wherein each object specifies a digital image, as well as other attributes, of its corresponding assembly component. (Column

5, lines 34-39; FIG 5, 86: The augments electronic document is stored on a mass storage device (Col 8, line 16-19) wherein the document contain pages (objects or digital images) with each page containing parameters are stored on the mass storage device. Column 4, line 66 – Column 5, line 25 discloses the attributes of each page that would be saved.)

As per dependent claim 38, Markovic et al discloses wherein the image is generated in step (d) based upon stored relative position information and stored overlap information associated with the physical assembly components. (Column 4, lines 39-50 discloses the use of adding binding properties to the document. A user can select parameters that adds images of hole punches or drill holes, and folding and cutting locations. Column 5, lines 1-25 discloses the use of graphics overlaying the digital images of the document, and may obscure portions of the text that may or may not be changed which are generated based on the selection of the parameters and displayed after chosen by the user (Column 4, lines 51-65). Thus, Markovic et al stores relative position information and stored overlap information.

As per dependent claims 40, Markovic et al discloses further comprising a step of responding to a command to submit an order for the assembled document by transmitting the custom-design information to a processing facility. (Column 2, lines 47-58: User submits an instruction (or a order) to the document assembler (Col. 1, line 38-39) to print out an hard copy of the augment electronic document and assemble the hard copy document in accordance with the instructions for augmenting the document.)

As per dependent claim 42, Markovic et al discloses wherein the custom-design information includes where to bind the assembled document (Column 4, lines 39-50)

As per dependent claim 43, Markovic et al discloses wherein the custom-design information includes an instruction to fold a page in the assembled document (Column 4, lines 46-50; Column 7, line 60 – Column 8, line 3, Claim 29)

As per dependent claim 44, Markovic et al discloses wherein the custom-design information specifies a type of physical assembly component and further comprising a step of automatically selecting a specific physical assembly component based on said type and based on a property of the assembled of the assembled document, as indicated from the custom-design information. (The user can select which type pf physical component to add (Column 4, 28-50). Once selected the computer automatically adds instructions to the document and augments the document to follow the parameters that were selected. (e.g. Column 3, lines 39-48))

As per dependent claim 45, Markovic et al discloses wherein the property is a dimension of the assembled document. (Column 5, lines 28-31, 62-65: a paper thickness is a dimension)

As per dependent claim 46, Markovic et al discloses wherein the user interface permits the user to specify an ordered list of at least some of the physical assembly components, listing an order in which said at least some of physical assembly components are to appear in the assembled document (Column 6, lines 39-51: A list is generated listing all the document assembly parameters wherein it contains components capable of appearing and are to appear when selected. It is inherently

known when a list is generated it is generated in one order or another such as a random order or by name. Thus, then the user can select the parameters from the list, which include adding binding or index tabs.)

As per dependent claim 48, Markovic et al discloses wherein step (a) comprises providing a set of available physical assembly components that include at least two of: a binding, a front cover, a back cover, and a tab page. (Column 4, lines 28-50; binding, covers, tab page)

As per dependent claim 49, Markovic et al discloses wherein step (a) comprises providing a set of available physical assembly components that include sheets of different media types, and wherein the user interface permits the user to substantially arbitrarily insert said sheets of said different media types into the assembled document. (Column 4, lines 37-39: endpapers, interleaved blank sheets, and index tabs)

As per dependent claim 50, Markovic et al discloses the user interface permits the user to specify custom printing on at least some of the physical assembly components. (Column 4, lines 28-34)

As per dependent claim 52, and 53, Markovic et al discloses wherein the user interface permits the user to select an attribute for at least one of the selected physical assembly components wherein the attribute is color. (Column 5, lines 28-30, 62-65, Claim 23)

As per independent claim 55, Claim 55 recites similar limitations as in Claim 28, and is similarly rejected under rationale.

As per dependent claim 56, Claim 56 recites similar limitations as in Claim 29, and is similarly rejected under rationale.

As per dependent claim 57, Claim 57 recites similar limitations as in Claim 30, and is similarly rejected under rationale.

As per dependent claim 58, Claim 58 recites similar limitations as in Claim 31, and is similarly rejected under rationale.

As per dependent claim 59, Claim 59 recites similar limitations as in Claim 32, and is similarly rejected under rationale.

As per dependent claim 61, Claim 61 recites similar limitations as in Claim 34, and is similarly rejected under rationale.

As per dependent claim 63, Claim 63 recites similar limitations as in Claim 36, and is similarly rejected under rationale.

As per dependent claim 64, Claim 64 recites similar limitations as in Claim 37, and is similarly rejected under rationale.

As per dependent claim 65, Claim 65 recites similar limitations as in Claim 38, and is similarly rejected under rationale.

As per dependent claim 67, Claim 67 recites similar limitations as in Claim 40, and is similarly rejected under rationale.

As per dependent claim 69, Claim 69 recites similar limitations as in Claim 42, and is similarly rejected under rationale.

As per dependent claim 70, Claim 70 recites similar limitations as in Claim 43, and is similarly rejected under rationale.

As per dependent claim 71, Claim 71 recites similar limitations as in Claim 44, and is similarly rejected under rationale.

As per dependent claim 72, Claim 72 recites similar limitations as in Claim 45, and is similarly rejected under rationale.

As per dependent claim 73, Claim 73 recites similar limitations as in Claim 46, and is similarly rejected under rationale.

As per dependent claim 75, Claim 75 recites similar limitations as in Claim 48, and is similarly rejected under rationale.

As per dependent claim 76, Claim 76 recites similar limitations as in Claim 49, and is similarly rejected under rationale.

As per dependent claim 77, Claim 77 recites similar limitations as in Claim 50, and is similarly rejected under rationale.

As per dependent claim 79, Claim 79 recites similar limitations as in Claim 52, and is similarly rejected under rationale.

As per dependent claim 80, Claim 80 recites similar limitations as in Claim 53, and is similarly rejected under rationale.

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 33, 35, 39, 44, 47, 51, 54, 60, 62, 66, 68, 74, 78, and 81 rejected under 35 U.S.C. 103(a) as being unpatentable over Markovic et al (US Patent #7,047,490, filed 11/26/1997).

As per dependent claim 33, Markovic et al fails to specifically disclose wherein the user interface provides the user an ability to designate only a portion of the source file for generating the set of printed-page images. However, Markovic et al discloses that once the source document has been created, the user converts the source document into a PDF document by using the "print to PDF" option process by use of Acrobat products and/or methods, which is then opened by the virtual document assembly program. (Column 4, lines 8-23) It was well-known to one of ordinary skill at the time of Applicant's invention that when a user decides print the source document either to a printer or to a PDF file, that the user has the ability set the page range of which pages the user wishes to print. Therefore, it would have been obvious to one of ordinary skill in the art to have modified Markovic et al's invention with the ability to set the page range for print a document since it would provide the ability of the user of printing information that is needed as a hard copy or to PDF without wasting additional paper, or increasing performance cost of computer resources.

As per dependent claim 35, Markovic et al fails to discloses wherein the user command is an instruction to turn a single page. However, Markovic et al discloses that the augment document is a PDF file and the virtual document assembly program uses a PDF file editor. (Column 5, lines 38-40; Col 6, lines 8-11) It was well-known in the art that at the time of the invention that PDF viewers/editors such as Adobe Acrobat

includes the ability to turn to the next page of a PDF document file. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified Markovic et al invention of being able to view PDF files in a PDF file viewer/editor with a turn to the next page option since it would allow the user to be able to flip through the document at the user's pace with just one easy accessible option of hitting the next page function.

As per dependent claim 39, Markovic et al fails to specifically disclose if its possible to create an assembled document specified by the custom-design information and outputting an error message if it is not possible. However, it was well-known in the art at the time of Applicant's invention that error notification occurs wherein character or information inputted that does not agree within the programming of the software or within the computer system such as file permissions or authorization. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have implemented an error message notification to prevent a user from augmenting a protected document and/or allowing the user to be inform if he or she is able to use the inputs that was inputted.

As per dependent claim 41, Markovic et al discloses the computer system communications may connect to another computer through an internetwork link. (Column 6, lines 2-6) However, Markovic et al fails to specifically disclose wherein the custom-design information is transmitted via an internet connection. However, it was well-known at the time of Applicant's invention to have transmitted data information through computers regardless of their location using an internetwork connection. It

would have been obvious to one of ordinary skill in the art at the time of Applicant invention to have use an internet connection with Markovic et al's invention since it provides quicker distribution and less time for distributing data among others.

As per dependent claim 47, Claim 47 recites similar limitations as in Claim 46, and is similarly rejected under rationale. Furthermore, Markovic et al fails to specifically disclose wherein the user interface permits the user to alter the order in which said at least some of the physical assembly components are to appear in the assembled document. However, it was well-known to one of ordinary skill in the art at the time of Applicant's invention that computer generated list of any files may include the file name, file size, file created date, etc wherein a user can reorganize the order listed by size or by date since it would have provided the benefit to Markovic of allowing flexible ease for searching by locating the file using its attributes or properties.

As per dependent claim 51, Markovic et discloses inserting index tab pages (column 4, 37-39); however, fails to specifically discloses specifies text to be included on a tab located on the tab page. However, it was well-known in the art at the time of Applicant's invention for text to be included on the tab of a tab page since it provided the ability for the user to label different sections of a document, and have an easier access to view a particular section by using a tab page.

As per dependent claim 54, Markovic et al fails to specifically disclose wherein the user interface does not permit printing on at least some of the selected physical assembly components. However, Markovic et al discloses the insertion of interleaved blank pages. (Column 4, lines 37-39) It would have obvious to one of ordinary skill in the

art at the time of Applicant's invention that a user would not be able to print on the interleaved blank sheets since the intended purpose for a blanked sheet is to be blank wherein the user can use as a divider between pages in a document.

As per dependent claim 60, Claim 60 recites similar limitations as in Claim 33, and is similarly rejected under rationale.

As per dependent claim 62, Claim 62 recites similar limitations as in Claim 35, and is similarly rejected under rationale.

As per dependent claim 66, Claim 66 recites similar limitations as in Claim 39, and is similarly rejected under rationale.

As per dependent claim 68, Claim 68 recites similar limitations as in Claim 41, and is similarly rejected under rationale.

As per dependent claim 74, Claim 74 recites similar limitations as in Claim 47, and is similarly rejected under rationale.

As per dependent claim 78, Claim 78 recites similar limitations as in Claim 51, and is similarly rejected under rationale.

As per dependent claim 81, Claim 81 recites similar limitations as in Claim 54, and is similarly rejected under rationale.

### ***Double Patenting***

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 28-81 are rejected under the judicially created doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-69 of U.S. Patent #6,616,702. An obviousness-type double patent rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claims because the examined claims are either anticipated by, or would have been obvious over the reference claims. See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 28, and 55 are generic to the method and computer-readable medium recited in claims 1 and 31, respectively, of U.S. Patent #6,616,072. That is, claim 28, and 55 are anticipated by claims 1, and 31, of US Patent 6,616,072.

***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

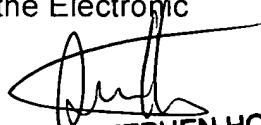
- Anderson et al (US Patent #5,903,905): Discloses the ability to construct and display a preview of a document that provides an accurate customized document.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Faber  
Patient Examiner  
AU 2178



STEPHEN HONG  
SUPERVISORY PATENT EXAMINER